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Application No. 10/825,522
Reply dated January 20, 2011
Reply to Office Action of August 4, 2010**REMARKS**

In the Office Action, the Examiner rejected claims 6-8 and 11-13 under 35 U.S.C. § 102(e) as being clearly anticipated by U.S. Patent No. 6,575,981 to Boyd et al. ("981 patent") via U.S. Provisional Application No. 60/118,793 ("793 provisional application") (which incorporates by reference U.S. Provisional Application No. 60/115,388 ("388 provisional application")); and rejected claims 1-5, 9, 10, 14, and 15 under 35 U.S.C. § 103(a) as being unpatentable over the '981 patent, via the '793 provisional application. Applicant respectfully traverses the rejections.

The '981 patent issued from U.S. Application No. 09/498,426, filed on February 4, 2000, which claims the benefit of the filing date of the '793 provisional application, filed on February 4, 1999. The '793 provisional application incorporates by reference the '388 provisional application, filed on January 11, 1999. For at least the reasons set forth below, Applicant respectfully submits that the Examiner's reliance on the subject matter of the '388 provisional application to reject Applicant's claimed invention is improper.

According to 37 C.F.R. § 1.57(c), "[e]ssential material' may be incorporated by reference, but only by way of an incorporation by reference to a U.S. patent or U.S. patent application publication, which patent or patent application publication does not itself incorporate such essential material by reference." (37 C.F.R. § 1.57(c) (emphasis added)). The MPEP creates an exception for applications which serve "only to establish an earlier effective filing date" (see MPEP § 608.01(p)(I)(B), p. 600-98, col. 2 (Rev. 7, Sept. 2008)). Thus, the '793 provisional application is properly incorporated by reference in the '981 patent because the '981 patent claims priority to the '793 provisional application.

Applicant submits that the '388 provisional application is not properly incorporated by reference in the '793 provisional application for the purpose being used by the Examiner in rejecting Applicant's claims for at least the following reasons: (1) the '388 provisional application is not a U.S. patent or U.S. patent application publication (see 37 C.F.R. § 1.57(c)); and (2) the exception under MPEP § 608.01(p)(I)(B) does not apply because neither the '981 patent nor the '793 provisional application rely on the '388

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provisional application to establish an earlier effective filing date (see MPEP § 608.01(p)(I)(B)). Moreover, the '981 patent cannot rely on the '388 provisional application to establish an earlier effective filing date because the filing date of the '388 provisional application is more than one year prior to the filing date of the '981 patent; and the '793 provisional application cannot itself claim the benefit of another provisional application. (See 37 C.F.R. § 1.53(c)(4); see also MPEP § 201.04(b)).

Accordingly, Applicant respectfully submits that the rejections in view of the Examiner's attempted use of the '388 provisional application to reject the claims is improper and requests withdrawal of the rejections.

Applicant submits that independent claims 1, 6, and 11 are patentable and that dependent claims 2-5, 7-10, and 12-15, dependent from independent claim 1, 6, or 11, or claims dependent therefrom, are patentable at least due to their dependency from an allowable independent claim.

In view of the foregoing remarks, it is respectfully submitted that the claims are patentable. Therefore, it is requested that the Examiner reconsider the outstanding rejections in view of the preceding comments. Issuance of a timely Notice of Allowance of the claims is earnestly solicited.

To the extent any extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this reply, such extension is hereby respectfully requested. If there are any fees due under 37 C.F.R. §§ 1.16 or 1.17 which are not enclosed herewith, including any fees required for an extension of time under 37 C.F.R. § 1.136, please charge such fees to our Deposit Account No. 50-3726.

Respectfully submitted,

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Date: January 20, 2011

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